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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,863	03/31/2004	Edward Vaquero	P03166	5586
23702 7590 11/13/2008 Bausch & Lomb Incorporated One Bausch & Lomb Place Rochester, NY 14604-2701				
EXAMINER				
LANG, AMY T				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
11/13/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/813,863

Applicant(s)

VAQUERO, EDWARD

Examiner

AMY T. LANG

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-13 and 22-28 is/are pending in the application.
4a) Of the above claim(s) 26-28 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3,4,6-13 and 22-25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

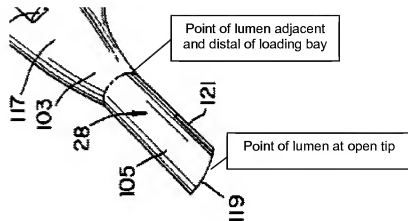
- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claims 1, 3, 4, 6-13, and 22-25 are pending and claims 26-28 are withdrawn.

1. **Claims 1, 3, 4, 6-8, 10, 12, and 22-25** are rejected under 35 U.S.C. 102(b) as being anticipated by Clark (US 6,491,697 B1).

With regard to **claims 1 and 7**, Clark discloses a device for injecting a foldable IOL into an eye comprising a body (22), an opening to receive an IOL (38), and a lumen (107) through cannula (28) (column 3, lines 62-64; column 6, lines 1-4). The opening (38) forms a loading bay for the IOL. As shown in Figure 1, the lumen comprises a proximal end and an open tip (119). Clark further teaches wherein the cannula (28) comprises a proximal taper to compress the IOL (column 5, lines 58-63). As shown in Figures 1-3, the cannula flares outward from the proximal taper to form a region of increasing diameter. Therefore, the lumen (107), which runs the length of the cannula, also comprises a region of increasing diameter from the proximal taper. This produces a larger inner diameter at the open tip than a region adjacent and distal to the opening (38).



With regard to **claims 3 and 22**, Clark further discloses a compressor drawer (40) comprising a leading edge (62) (column 4, lines 12-15). The compressor drawer moves from an open to a closed position to engage and compress the IOL (column 4, lines 28-40).

With regard to **claim 4**, the device also comprises a plunger (column 3, lines 50-54).

With regard to **claim 6**, as shown in Figure 1, the device has an outer diameter that is substantially constant from the opening (38) to the open tip (119) since "substantially" is not narrowly defined.

With regard to **claims 8, 10, and 12**, as shown in Figures 1-3 of Clark, the region of increase is gradual.

With regard to **claims 23 and 24**, the proximal taper of the cannula (28) and lumen (107) forms a first diameter at a location that is adjacent and distal of the loading bay (38). The slightly flared distal end of the cannula and lumen forms a second

diameter at the open tip (119). As shown in Figures 1-3, the second diameter is larger than the first diameter.

With regard to **claim 25**, it is the examiner's position that the compressor of Clark overlaps the instantly claimed compressor drawer.

Claim Rejections – 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 9, 11, and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark (US 6,491,697 B1).

Clark discloses a device for injecting a foldable IOL lens into an eye wherein the inner lumen increases in diameter. However, Clark does not teach wherein inner lumen increase in diameter is stepped.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the increase of the inner lumen to a stepped increase because Applicant has not disclosed the modification provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a gradual increase, as disclosed by Clark, because the lumen is able to receive an IOL lens. Therefore, it would have been an obvious matter of design choice to modify Clark to obtain the invention as specified in the claims.

Response to Arguments

5. Applicant's arguments, filed 07/30/2008, with respect to Figueroa have been fully considered and are persuasive. The rejections have been withdrawn.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMY T. LANG whose telephone number is (571)272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3731